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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,042	04/03/2001	Francois Rodrigue		9286
7590	07/01/2004		EXAMINER	
FRANCOIS RODRIGUE 4164 AVE. PARC LA FONTAINE MONTREAL, QC H2L 3M8 CANADA			THOMPSON JR, FOREST	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/824,042	RODRIGUE, FRANCOIS
	Examiner Forest Thompson Jr.	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 June 2001.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-5 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 03 April 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-5 are rejected.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A method and apparatus for packaging homogeneous content into mini-subscriptions or the step(s) for the use of mini-subscription being the model, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Claim 1 states "a method and apparatus for packaging homogeneous content into mini-subscriptions" at line 1, and "the mini-subscription being the model used to offer access or to present content" at line 6, but not any particular steps used to enable either invention. Two separate inventions in the prior art are presented by this disclosure that would require different searches of the prior art. Correction is required.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 provides for the use of a mini-subscription as a model to offer access, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Dependent claims 2-5 are dependent from independent claim 1. Therefore, the same rejection is applied to claims 2-5.

Additionally, regarding claim 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Therefore, dependent claim 2 is rejected.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Dependent claims 2-5 depend from rejected independent claim 1. Therefore, the same rejection is applied to dependent claims 2-5.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,108,639), and further in view of Buist (U.S. Patent No. 6,408,282), and Lappington et al. (U.S. Patent No. 5,734,413).

For the purpose of expediting prosecution, prior art is indicated below that teaches specific aspects that appear to be related to applicant's intended invention, as understood by examiner. This indicated prior art is applied by examiner for the purpose of illustrating the existing prior art that may be applied in rejecting applicant's instant invention, once other issues have been addressed/corrected, as per sections 2-7 above. Applicant's instant invention is currently rejected (see sections 2-7 above).

Claims 1-5: Prior art teaches on-line methods and systems for packaging content for distribution to subscribers, and providing incentive to potential end-users to pay in order

to have access to content through subscriptions to a service or provider. Examples of such prior art include:

- Walker et al. teaches:
  - A collectible conditional purchase offer (CPO) management system for receiving and processing individual CPOs from buyers for one or more collectibles, such as coins, stamps, art prints, comic books, baseball cards, jewelry, or other used or secondary market goods. The collectible CPO management system processes each received CPO to determine whether one or more sellers are willing to accept a given collectible CPO. If a seller accepts a given CPO, and ultimately delivers goods complying with the buyer's CPO, the buyer is bound on behalf of the accepting seller, to form a legally binding contract. In order to ensure that at least one of the accepting sellers will have the collectible item in the condition specified by the buyer, a number of sellers may conditionally accept each CPO. Each of the accepting seller(s) are preferably prioritized into a hierarchy based on predetermined criteria.

(Abstract)

- As discussed below in conjunction with FIG. 9, individual sellers preferably contact the collectible CPO management system 100 to provide a list of the inventory available for sale from the seller's collection. In addition, as discussed below in conjunction with FIG. 10, buyers preferably contact the collectible CPO management system 100 to evaluate the available inventory and, if desired, submit a CPO for one or more collectibles, or other used or secondary market goods. In one embodiment, the available inventory can be made available for buyers to

evaluate, without revealing any information identifying the seller. In an alternate embodiment, buyers can submit CPOs directly, without first evaluating available inventory. (col. 6 lines 28-40)

- Buist teaches:

-- Once the user's logon is complete, the application receives, at step 1860, the user's filtered information based on user's preferences saved on the replica server. In an alternate embodiment, the application receives unfiltered or partially filtered information from the replica database, and the application does further filtering once the information has been received. The application then, at step 1865, displays (depending on the user's display preferences) a master trade screen showing all critical trade data, based on the user's preferences. As the user's position in his stocks changes, the replica database and server, at step 1870, automatically updates the user's display in real-time. Each time a change occurs in the information held on the replica server, the master database is updated accordingly at step 1840. (col. 17 lines 33-47)

-- FIG. 30 is a flow diagram illustrating software of the preferred embodiment for alerting a user to movements in stock price according to user-defined preferences. Initially, the user makes a decision, at step 3010, to have the system monitor stock movements and alert him/her accordingly. At step 3015, the user views basic information for different stocks by selecting alternate summary screen views, which include: (1) the stocks held in the system by the user; (2) the stocks that are among

the most active in the current market; and (3) stocks that the user would like to monitor. (col. 23 lines 20-40)

-- In the United States, the trading of securities is closely regulated under the Securities Exchange Act of 1934, 15 U.S.C. .sctn..sctn.78a-78mm. The term "security" is defined in 15 U.S.C. .sctn.78c(a)(10) as "any note, stock, treasury stock, bond, debenture, certificate of interest or participation in any profit-sharing agreement or in any oil, gas, or other mineral royalty or lease, any collateral-trust certificate, preorganization certificate or subscription, transferable share, investment contract, voting-trust certificate, certificate of deposit, for a security, any put, call, straddle, option, or privilege on any security, certificate of deposit, or group or index of securities (including any interest therein or based on the value thereof), or any put, call, straddle, option, or privilege entered into on a national securities exchange relating to foreign currency, or in general, any instrument commonly known as a 'security'; or any certificate of interest or participation in, temporary or interim certificate for, or warrant or right to subscribe to or purchase, any of the foregoing . . . but shall not include currency or any note draft, bill of exchange, or banker's acceptance which has a maturity at the time of issuance of not exceeding nine months, exclusive of days of grace, or any renewal thereof the maturity of which is likewise limited." Stocks are specific instances of securities. Although the preferred embodiment is primarily concerned with computerized stock trading, it is fully applicable to trading of any securities. (col. 1 lines 15-41)

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-- In the preferred embodiment, each of a multiplicity of users' workstations is simultaneously connected via the Internet to one of a plurality of broker/dealer computers and to a user-to-user trading system. Each broker's computer stores the account data and similar information customarily stored at a broker's server computer for the broker's clients. The preferred system communicates with each broker's server computer and in addition provides real-time updates for stock quotes both as a part of the service supporting day trading on national exchanges and as part of the service supporting user-to-user trading. For the user-to-user trading service the system maintains real-time data reflecting buy and sell orders for the supported securities, and is capable of displaying the same information for national exchanges if that data is provided by the exchange(s). This data reflecting users' orders to buy and sell for each security is referred to as the "order book" for a security. The users interested in a given security receive at their workstations real-time displays of the order book for that security. In one embodiment of the invention, such order book information is selectively provided to users on a subscription basis. It is also capable of being displayed (free, or for a fee) by Internet portals such as Yahoo!, Altavista, etc. (col. 6 lines 26-48)

- Lappington et al. teaches (col. 4 line 10 – col. 5 line 2):

Interactive television adds an exciting dimension to current television programming by increasing viewer involvement. For example, interactive television can make game shows more exciting for viewers who can play along with the on-air

contestants. Sporting events become more fun for viewers who can judge competitions, match wits with the coaches and test their knowledge of the game, its stars and history. Original classics, reruns and re-aired programs are more entertaining for viewers who participate in solving mysteries and puzzles, and answering trivia and pop culture questions. News, documentary, and talk shows are more compelling for viewers who receive additional information on the subjects on which they are interested in, participate in polls on topics that concern them, and learn important self-help tips. Movies can be enriched with trivia games and information. Music videos, specials and variety shows are more interesting with viewer judging, surveys and pop culture questions. New programs, including premiers and special events will attract larger audiences through interactive promotions and contests. Interactive promotions and contests provide an incentive for viewers to stay with programs for their entirety, and to tune into a series consistently over the course of a day, week, or season.

Additionally, interactive television creates an active viewing experience that can highlight the educational, informational and public service aspects of television. As a result, viewers will feel better about their television viewing, and thus will be more interested in watching television for longer periods of time. For example, interactive television could be used to turn cartoons into learning and entertaining experiences. A TOM AND JERRY cartoon could include an interactive question asking, "If Tom caught 22 mice and ate 10, how many would he have left?" Thus, a child can enjoy cartoons and simultaneously learn.

Interactive television's enhancement of the viewer's experience translates into benefits for networks, producers and advertisers. An interactive television system can increase viewership, build viewer loyalty, increase television's educational value, enhance a networks image, enhance on-air promotion, create new opportunities for advertiser involvement, enable a network or cable station to get to know its audience and generate additional sources of revenue. Furthermore, interactive programs can increase viewer awareness and promotional exposure without decreasing ad spot inventory. For example, interactive programming can be an ideal tool for creating self-liquidating promotional campaigns utilizing advertiser tie-ins. Special messages and games can entice viewers to watch commercials. Alternatively, a network can team with sponsors to promote and benefit from merchandising possibilities such as logo merchandising, marketing clothes and selling books authored by talk show guests.

Furthermore, interactive programming allows networks, advertisers, or other interested entities to understand the audience by taking advantage of interactive televisions' data gathering tools. For example, audience demographics, such as number, age, gender and income of viewers, can be collected. Polling questions can be asked to determine the likes and dislikes of a given audience.

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify the teachings of Walker et al. to explicitly teach packaging homogeneous content into mini-subscriptions, as taught by the combination

of Walker et al., Buist and Lappington et al., for the motivation of packaging content for presentation to end-users on a subscription basis into content packages that attract end-users to subscribe.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art includes:

- Walker et al. (U.S. Patent No. 5,926,796) that teaches a system that comprises a point-of-sale (POS) terminal, a POS controller, a retail subscription system. The POS terminal allows a cashier to enter subscription sales data into the POS controller. The POS controller maintains databases on available subscriptions and produces databases containing data relating to subscriptions sold to customers.
- Lotvin et al. (U.S. Patent No. 5,907,831) that teaches educational material is provided at a child's local computer under control of a central computer system connected to it over a computer network. On completing a particular educational task, the child is rewarded with a certain number of points. Points that the child accumulates are stored centrally, and at least some of the points can be redeemed towards the purchase of goods and services offered through the system of the preferred embodiment by its commercial participants. The purchasing transactions are also administered by the central computer. Parents, preferably, use the system to support their children's purchasing activity financially and to select content available for presentation to the child. In other embodiments, the disclosed apparatus and methods

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can be used for purposes unrelated to education of children, and distribution of functionality between the central and local computers may be different, including wholly local implementations.

- Garg et al. (U.S. Patent No. 6,571,216) that teaches a plurality of reward scheme owners to give differential rewards, through a plurality of reward distribution agents, to various users based on the user profile. The reward scheme owner may be a seller, a manufacturer, a sales promotion agent or even an intermediary. Similarly, the reward distribution agent may be an on-line or a physical retailer, a broker, a seller or an intermediary. Also the users may be consumers, businesses, brokers or other intermediaries.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT *N*  
06/25/2004



Jeffrey A. Smith  
Primary Examiner

It appears that the applicant in this application is a *pro se* applicant (an inventor filing the application alone without the benefit of a Patent Attorney or Agent). Applicant may not be aware of the preferred methods of ensuring timely filing of responses to communications from the Office and may wish to consider using the Certificate of Mailing or the Certificate of Transmission procedures outlined below.

#### **CERTIFICATE OF MAILING**

To ensure that the Applicant's mailed response is considered timely filed, it is advisable to include a "certificate of mailing" on at least one page (preferably on the first page) of the response. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on (date).

(Typed or printed name of the person signing this certificate)

(signature)

#### **CERTIFICATE OF TRANSMISSION**

Alternatively, if applicant wishes to respond by facsimile rather than by mail, another method to ensure that the Applicant's response is considered timely filed, is to include a "certificate of transmission" on at least one page (preferably on the first page) of the response. This method should be used by foreign applicants without access to the U.S. Postal Service. This "certificate" should consist of the following statement:

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) \_\_\_\_ - \_\_\_\_ on (date).

(Typed or printed name of the person signing this certificate)

(signature)

These "Certificates" may appear anywhere on the page, and may be handwritten or typed. They must be signed, and the date must be the actual date on which it is mailed or transmitted. For the purpose of calculating extensions of time, the date shown on the certificate will be construed as the date on which the paper was received by the Office, regardless of the date the U.S. Postal Service actually delivers the response, or the fax is "date-stamped" in. In this way, postal or transmission delays do not affect the extension-of-time fee.

In the event that a communication is not received by the Office, applicant's submission of a copy of the previously mailed or transmitted correspondence showing the **originally** signed Certificate of Mailing or Transmission statement thereon, along with a statement from the person signing the statement which attests to the timely mailing or transmitting of the correspondence, would be sufficient evidence to entitle the applicant to the mailing or transmission date of the correspondence as listed on the Certificate of Mailing or Transmission, respectively.

**NOTICE TO APPLICANT:** In the case of lost or late responses the use of other "receipt producing" forms of mailing a correspondence to the Patent Office, such as Certified Mail, or a private shipper such as FedEx, **WILL NOT** result in the applicant getting the benefit of the mailing date on such receipts. These receipts are **not** considered to be acceptable evidence since there is nothing to "tie-in" the receipt with the particular document allegedly submitted.